



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/532,402	03/22/2000	Michael A. Kepler	1631077-0031	8303

7590

06/06/2002

Alex L Yip
Kaye Scholer LLP
425 Park Avenue
New York, NY 10022

EXAMINER

LY, ANH

ART UNIT

PAPER NUMBER

2172

DATE MAILED: 06/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/532,402

Applicant(s)

KEPLER ET AL.

Examiner

Anh Ly

Art Unit

2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 03/20/2002 with respect to claims 1-35 have been considered but are moot in view of the new ground(s) of rejection.
2. Claims 1-35 are pending in this application.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 6 and 10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of Application Serial No. 09/289,457. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 6 and 10 in application 09/532,402 recite similar limitations in claims 1 and 8 of the application 09/289,457. They recite the same a search-routing database, said search-routing database including search-routing database records...and one or more of said database fields, receiving a query from a user...; selecting search request...; searching said search-routing database...; routing the query to the databases; input device for receiving a query from a user...; a search engines for searching said search-routing database... said database identifiers identifying one or more database.
5. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

Art Unit: 2172

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-6 and 29-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,369,763 issued to Biles.

With respect to claim 1, Biles discloses maintaining one or more update databases with a plurality of update records, the update records including at least one indication of whether a database record should be excluded from a search result (abstract, col. 2, lines 30-67, col. 3, lines 1-14, col. 7, lines 38-54, col. 27, lines 25-67 and col. 28, lines 1-65); searching a database for database records responsive to a query and returning database records responsive to the query and searching an update database associated with the database for database records responsive to the query and returning update records responsive to the query (col. 7, lines 21-38, col. 27, lines 52-66, col. 28, lines 54-67, col. 31, lines 40-64 and see fig. 13); and excluding from the search results database records that correspond to returned update records if the update records include an indication that the database record should be excluded from the search (col. 27, lines 12-17, col. 34, lines 49-67, col. 35, lines 1-21 and col. 39, lines 49-61).

Biles does not clearly disclose "including at least one indication of whether a database record should be excluded from search result." But, however, Biles shows duplicating record are removed (col. 34, lines 49-67, col. 35, lines 1-21 and col. 39, lines 49-61). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Biles such as updating databases, records, fields, search results, and removing records so as to obtain a method of updating database records and information retrieval system that facilitates collecting, cataloging, storing, searching, locating, querying, retrieving and displaying information (Biles – col. 5, lines 45-67) in the searching, accessing and updating databases environment.

With respect to claim 2, Biles discloses the search results at least one update record that does not include an indication that the database record should be excluded from a search (col. 27, lines 12-17, col. 34, lines 49-67, col. 35, lines 1-21 and col. 39, lines 49-61).

With respect to claim 3, Biles discloses wherein the indication comprises at least one field configurable to at least one predefined value (col. 25, lines 35-44).

With respect to claim 4, Biles discloses wherein database records and update records include a plurality of fields, and database records and update records correspond when the fields of a database record are substantially similar to the fields of an update record (col. 32, lines 18-32).

With respect to claim 5, Biles discloses identifying one or more update databases associated with a database (col. 27, lines 25-67, col. 28, lines 1-67, col. 29, lines 1-15 and col. 39, lines 29-38).

With respect to claim 6, Biles discloses maintaining a search-routing database, said search-routing database including a plurality of search-routing database records comprised of search-routing database fields, said search-routing database fields including a database-identifier field and one or more database fields; receiving a query from a user, said query comprised of search request data in search request fields of predetermined types; selecting search request data in at least one of the search fields; searching said search-routing database for one or more database identifiers, based on the selected search request data; and routing the query to the databases identified by said database identifiers and the update databases associated therewith (col. 1, lines 14-26, col. 6, lines 7-10, and lines 33-39, col. 8, lines 64-67, and col. 9, lines 1-22, col. 13, lines 20-66, col. 14, lines 53-67, and col. 17, lines 21-46; col. 19, lines 36-47, and col. 25, lines 19-28; col. 10, lines 59-67, col. 11, lines 1-7, col. 13, lines 20-66, and col. 25, lines 19-28; col. 10, lines 21-38, and lines 59-67, and col. 11, lines 30-43; see fig. 4, col. 9, lines 1-22, and lines 55-63, and col. 41, lines 10-18; col. 10, lines 59-67, col. 11, lines 1-7; col. 9, lines 1-22, and lines 55-63, col. 10, lines 59-67, and col. 11, lines 1-7, and col. 41, lines 10-18).

With respect to claim 29, Biles discloses maintaining a routing database for identifying one or more database to search in response to a search request; receiving the search request; searching the routing database to determine at least one route to

Art Unit: 2172

one or more databases to search in response to the search request; if the search of the routing database is successful, routing the search request to a database identified by the routing database; and in other instances, routing the search request to a database identified by one or more default routes (abstract, col. 2, lines 30-67, col. 3, lines 1-14, col. 7, lines 38-54, col. 27, lines 25-67 and col. 28, lines 1-65; col. 7, lines 21-38, col. 27, lines 52-66, col. 28, lines 54-67, col. 31, lines 40-64 and see fig. 13; col. 2, lines 30-67, col. 7, lines 25-53, col. 27, lines 48-65, col. 29, lines 15-67 and col. 30, lines 1-32).

Biles does not clearly disclose "receiving the search request." But, however, Biles shows the search query or query for the searching as search request (col. 27, lines 48-65, col. 29, lines 15-67 and col. 30, lines 1-32). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Biles such as updating databases, records, fields, search results, and removing records so as to obtain a method of updating database records and information retrieval system that facilitates collecting, cataloging, storing, searching, locating, querying, retrieving and displaying information (Biles – col. 5, lines 45-67) in the searching, accessing and updating databases environment.

With respect to claim 30, Biles discloses analyzing the search request identify one or more items of routing data (col. 29, lines 15-67 and col. 30, lines 1-32).

With respect to claim 31, Biles discloses searching a routing database with the identified one or more items of routing data to identify one or more databases to which the search request should be routed (col. 2, lines 37-52, col. 11, lines 44-56 and col. 19, lines 10-67).

With respect to claim 32, Biles discloses wherein the routing databases identifies at least one route to one or more database that are appropriate to search in response to the search request (col. 2, lines 30-67, col. 7, lines 25-53, col. 27, lines 48-65, col. 29, lines 15-67 and col. 30, lines 1-32).

With respect to claim 33, Biles discloses wherein the search request is routed to a database identified by the one or more default routes if the search request does not include a field that is used for routing (col. 27, lines 12-17, col. 34, lines 49-67, col. 35, lines 1-21 and col. 39, lines 49-61).

With respect to claim 34, Biles discloses wherein the search request is routed to a database identified by the one or more default routes if the search request includes a field that is used for routing but the field has an unspecified value (col. 25, lines 35-44).

With respect to claim 35, Biles discloses wherein the search request is routed to a database identified by the one or more default routes if the search request includes a field that is used for routing but the data populating the field does not correspond to any entries in the routing databases (col. 9, lines 36-67, col. 10, lines 1-67 and col. 12, lines 21-31).

9. Claims 7-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,369,763 issued to Biles in view of US Patent No. 5,987,454 issued to Hobbs.

With respect to claim 7, Biles discloses a plurality of databases, said databases including database records having database fields; one or more update databases, said

Art Unit: 2172

update databases including update records having update database fields, at least one of the update database fields indicating how to update a database record; and a sorter for generating results from the search of the databases and update databases, and excluding from the results database records that correspond to update records if the update records include an indication that the database record should be excluded from the search (col. 1, lines 14-26, col. 6, lines 7-10, and lines 33-39, col. 8, lines 64-67, and col. 9, lines 1-22, col. 13, lines 20-66, col. 14, lines 53-67, and col. 17, lines 21-46; col. 19, lines 36-47, and col. 25, lines 19-28; col. 10, lines 59-67, col. 11, lines 1-7, col. 13, lines 20-66, and col. 25, lines 19-28; abstract, col. 13, lines 55-67 and col. 14, lines 1-20; col. 27, lines 12-17, col. 34, lines 49-67, col. 35, lines 1-21 and col. 39, lines 49-61).

Biles does not explicitly indicate, "a search engine for searching one or more of the databases for database records responsive to a query, returning database records responsive to the query, searching one or more update databases associated with the databases for update records responsive to the query, and returning update records responsive to the query."

However, Hobbs discloses search engines (abstract, col. 5, lines 22-36, col. 8, lines 30-52, col. 10, lines 44-67, col. 11, lines 1-3, col. 16, lines 60-67, col. 17, lines 1-32 and col. 18, lines 49-67).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Biles with the teachings of Hobbs so as to have a system for updating database records because the combination would have an information retrieval system that facilitates collecting, cataloging, storing,

Art Unit: 2172

searching, locating, querying, retrieving and displaying information (Biles – col. 5, lines 45-67) in the searching, accessing and updating databases environment.

With respect to claim 8, Biles discloses wherein the generated results include at least one update record that does not indicate that at least one database record should be excluded from the search (col. 27, lines 12-17, col. 34, lines 49-67, col. 35, lines 1-21 and col. 39, lines 49-61).

With respect to claim 9, Biles discloses wherein database records and update records correspond when the fields of a database record are substantially similar to the fields of an update record (col. 31, lines 35-63 and col. 32, lines 26-33).

With respect to claim 10, Biles discloses a search-routing database, said search-routing database including search-routing database records comprised of search-routing database fields, said search-routing database fields including a database-identifier field and one or more said database fields; an input device for receiving a query from a user, said query comprised of search request data in search request fields of predetermined types; a search router for receiving the query and selecting search request data in at least one of the search fields (col. 1, lines 14-26, col. 6, lines 7-10, and lines 33-39, col. 8, lines 64-67, and col. 9, lines 1-22, col. 13, lines 20-66, col. 14, lines 53-67, and col. 17, lines 21-46; col. 19, lines 36-47, and col. 25, lines 19-28 and lines 35-44; col. 10, lines 59-67, col. 11, lines 1-7, col. 13, lines 20-66, and col. 25, lines 19-28; col. 10, lines 21-38, and lines 59-67, and col. 11, lines 30-43; see fig. 4, col. 9, lines 1-22, and lines 55-63, and col. 41, lines 10-18; col. 10, lines 59-67,

col. 11, lines 1-7; col. 9, lines 1-22, and lines 55-63, col. 10, lines 59-67, and col. 11, lines 1-7, and col. 41, lines 10-18).

Biles does not explicitly indicate, "a search engine for searching said search-routing database for one or more database identifiers, said database identifiers identifying one or more databases having database records responsive to said query."

However, Hobbs discloses search engines (abstract, col. 5, lines 22-36, col. 8, lines 30-52, col. 10, lines 44-67, col. 11, lines 1-3, col. 16, lines 60-67, col. 17, lines 1-32 and col. 18, lines 49-67).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Biles with the teachings of Hobbs so as to have a system for updating database records because the combination would have an information retrieval system that facilitates collecting, cataloging, storing, searching, locating, querying, retrieving and displaying information (Biles – col. 5, lines 45-67) in the searching, accessing and updating databases environment.

With respect to claim 11, Biles discloses a table for identifying one or more update databases associated with one or more databases having database records responsive to said query (col. 10, lines 21-38, col. 15, lines 40-46 and col. 27, lines 58-66).

With respect to claim 12, Bile discloses a method of routing search requests comprising: receiving a search request; searching a routing database to determine whether the search request should be routed to the one or more databases accessible; and if it is determined that the search request should be routed to the one or more

Art Unit: 2172

databases accessible: routing the search request to the one or more databases accessible; searching the one or more databases of the receiving server; and returning the results of the search (col. 1, lines 14-26, col. 6, lines 7-10, and lines 33-39, col. 8, lines 64-67, and col. 9, lines 1-22, col. 13, lines 20-66, col. 14, lines 53-67, and col. 17, lines 21-46; col. 19, lines 36-47, and col. 25, lines 19-28 and lines 35-44; col. 10, lines 59-67, col. 11, lines 1-7, col. 13, lines 20-66, and col. 25, lines 19-28).

Biles does not explicitly indicate, "receiving server the search request to be routed to."

However, Hobbs, discloses the proxy server and database server as claimed (col. 10, lines 44-67, col. 14, lines 25-67 and col. 15, lines 1-28).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Biles with the teachings of Hobbs so as to obtain a method of routing search request because the combination would have an information retrieval system that facilitates collecting, cataloging, storing, searching, locating, querying, retrieving and displaying information (Biles – col. 5, lines 45-67) in the searching, accessing and updating databases environment.

With respect to claim 13, Biles discloses wherein the determining includes analyzing the search request to identify one or more items of routing data (col. 7, lines 25-38, col. 10, lines 21-38 and lines 63-67 and col. 11, lines 1-14).

With respect to claims 14-15 and 18-19, Biles discloses a method of routing search requests as discussed in claim 12.

Biles does not explicitly indicate, "routing the search request to a second server if it is determined that the search request should not be routed to the databases accessible by the receiving server."

However, Hobbs discloses the proxy server and database server as claimed (col. 10, lines 44-67, col. 14, lines 25-67 and col. 15, lines 1-28).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Biles with the teachings of Hobbs so as to obtain a method of routing search request because the combination would have an information retrieval system that facilitates collecting, cataloging, storing, searching, locating, querying, retrieving and displaying information (Biles – col. 5, lines 45-67) in the searching, accessing and updating databases environment.

With respect to claim 16, Biles discloses routing the search request to an update database having a plurality of records for updating one or more of the databases (col. 26, lines 3-10 and col. 31, lines 35-67).

With respect to claim 17, Biles discloses merging the search results returned from the databases with the search results returned from the update database (col. 36, lines 45-64 and col. 39, lines 49-62).

Claim 20 is essentially the same as claim 12 except that it is directed to a system for routing search requests rather than a method ('763 of col. 1, lines 14-26, col. 6, lines 7-10, and lines 33-39, col. 8, lines 64-67, and col. 9, lines 1-22, col. 13, lines 20-66, col. 14, lines 53-67, and col. 17, lines 21-46; col. 19, lines 36-47, and col. 25, lines 19-28 and lines 35-44; col. 10, lines 59-67, col. 11, lines 1-7, col. 13, lines 20-66, and col. 25,

lines 19-28; '454 of col. 10, lines 44-67, col. 14, lines 25-67 and col. 15, lines 1-28), and is rejected for the same reason as applied to the claim 12 hereinabove.

Claim 21 is essentially the same as claim 13 except that it is directed to a system for routing search requests rather than a method (col. 7, lines 25-38, col. 10, lines 21-38 and lines 63-67 and col. 11, lines 1-14), and is rejected for the same reason as applied to the claim 13 hereinabove.

Claim 22 is essentially the same as claim 14 except that it is directed to a system for routing search requests rather than a method (col. 10, lines 44-67, col. 14, lines 25-67 and col. 15, lines 1-28), and is rejected for the same reason as applied to the claim 14 hereinabove.

Claim 23 is essentially the same as claim 15 except that it is directed to a system for routing search requests rather than a method (col. 10, lines 44-67, col. 14, lines 25-67 and col. 15, lines 1-28), and is rejected for the same reason as applied to the claim 15 hereinabove.

With respect to claims 24-25 and 27-28, Biles discloses a method of routing search requests as discussed in claim 20.

Biles does not explicitly indicate, "routing the search request to a second server if it is determined that the search request should not be routed to the databases accessible by the receiving server."

However, Hobbs discloses the proxy server and database server as claimed (col. 10, lines 44-67, col. 14, lines 25-67 and col. 15, lines 1-28).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Biles with the teachings of Hobbs so as to obtain a method of routing search request because the combination would have an information retrieval system that facilitates collecting, cataloging, storing, searching, locating, querying, retrieving and displaying information (Biles – col. 5, lines 45-67) in the searching, accessing and updating databases environment.

Claim 26 is essentially the same as claim 16 except that it is directed to a system for routing search requests rather than a method (col. 26, lines 3-10 and col. 31, lines 35-67), and is rejected for the same reason as applied to the claim 16 hereinabove.

Contact Information

10. Any inquiry concerning this communication should be directed to Anh Ly whose telephone number is (703) 306-4527. The examiner can be reached on Monday Friday from 8:00 AM to 4:00 PM.

If attempts to reach the examiner are unsuccessful, see the examiner's supervisor, Kim Vu, can be reached on (703) 305-4393.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

Art Unit: 2172

(703) 746-7238 (after Final Communication)

or:

(703) 746-7239 (for formal communications intended for entry)


or:

(703) 746-7240 (for informal or draft communications, or Customer Service Center, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Fourth Floor (receptionist).

Inquiries of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

ALC



JEAN M. CORRIELUS
PRIMARY EXAMINER

May 23rd, 2002.